

Appeal No. 2004-1081
Application 10/041,836

The opinion in support of the decision being entered today was not written for publication and is ***not*** binding precedent of the Board.

Paper No. 18

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MARSHALL O. TOWNSEND II

Appeal No. 2004-1081
Application 10/041,836

ON BRIEF

Before WARREN, OWENS and JEFFREY T. SMITH, *Administrative Patent Judges*.
WARREN, *Administrative Patent Judge*.

Decision on Appeal and Opinion

We have carefully considered the record in this appeal under 35 U.S.C. § 134, including the opposing views of the examiner, in the answer, and appellant, in the brief and reply brief, and based on our review, find that we cannot sustain the grounds of rejection advanced on appeal: claims 1, 11 through 13 and 20 stand rejected under 35 U.S.C. § 103 (a) as being unpatentable over Gibbs et al. (Gibbs) in view of Manley; claims 4 through 6, 10 and 25 through 31 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Gibbs in view of Manley as applied to claims 1 and 20 above, and further in view of Molinar; claim 9 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Gibbs in view of Manley as applied to claims 1 and 20 above, and further in view of Beatty and Long; and claims 21 and 22 stand rejected

under 35 U.S.C. § 103(a) as being unpatentable over Gibbs in view of Manley as applied to claims 1 and 20 above, and further in view of Florian.^{1,2}

It is well settled that in order to establish a *prima facie* case of obviousness under § 103(a), the examiner must show that some objective teaching, suggestion or motivation in the applied prior art taken as a whole and/or knowledge generally available to one of ordinary skill in this art would have led that person to the claimed invention as a whole, including each and every limitation of the claims arranged as required by the claims, without recourse to the teachings in appellant's disclosure. *See generally, In re Rouffet*, 149 F.3d 1350, 1358, 47 USPQ2d 1453, 1458 (Fed. Cir. 1998); *Pro-Mold and Tool Co. v. Great Lakes Plastics, Inc.*, 75 F.3d 1568, 1573, 37 USPQ2d 1626, 1629-30 (Fed. Cir. 1996); *In re Fritch*, 972 F.2d 1260, 1265-66, 23 USPQ2d 1780, 1783-84 (Fed. Cir. 1992); *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992); *In re Laskowski*, 871 F.2d 115, 10 USPQ2d 1397 (Fed. Cir. 1989); *In re Fine*, 837 F.2d 1071, 1074-76, 5 USPQ2d 1596, 1598-1600 (Fed. Cir. 1988). The requirement for objective factual underpinnings for a rejection under § 103(a) extends to the determination of whether the references can be combined. *See In re Lee*, 277 F.3d 1338, 1343, 61 USPQ2d 1430, 1433-34 (Fed. Cir. 2002), and cases cited therein.

We find that the examiner has not established a *prima facie* case of obviousness in any of the grounds of rejection for the reasons that appellant sets forth in the brief and reply brief, to which we add the following for emphasis.

The claimed golf swing training device encompassed by appealed claim 1, on which all other appealed claims depend, comprises at least a plurality of club path indicators and a swing reference guide comprising at least a plurality of shot selection types, such that the swing reference guide shows a plurality of shot selection types for each club path indicator. We find no limitation in claim 1, and indeed, no disclosure in the written description in the specification, specifying or permitting the selection of the club path to be dependent on the club selected rather than on the shot selected, and thus the plurality of club paths in the swing reference guide as claimed all apply to any one club.

¹ The rejected claims are all of the claims in the application. *See* the appendix to the brief.

² Answer, pages 3-7.

Appellant correctly points out that Gibbs alone and as combined with Manley would not have taught or suggested the claimed invention encompassed by appealed claim 1 to one of ordinary skill in this art. Indeed, while each of these references discloses in the specification and figures thereof a plurality of club paths, each club path is in fact specific to a specific shot based on a specific club in Gibbs (e.g., page 1, line 102, to page 2, line 7, and page 2, lines 17-26) and to a specific club in Manley (e.g., col. 1, line 68, to col. 2, line 35). Thus, even if one of ordinary skill in this art would have combined the teachings of these references as suggested by the examiner, that person would not have arrived at the claimed invention encompassed by appealed claim 1, including all of the limitations thereof arranged as required. *Uniroyal, Inc. v. Rudkin-Wiley Corp.*, 837 F.2d 1044, 1050-54, 5 USPQ2d 1434, 1438-41 (Fed. Cir. 1988).

Furthermore, we agree with appellant that integral plate element 15 and arms 16, to which we include adjustable indicator arm 21, of Molinar FIG. 1 as explained by the reference (e.g., col. 2, lines 34-41, and col. 2, line 51, to col. 3, line 14), do not pertain to club paths or club face indicators as the examiner alleges. Indeed, this disclosure is directed to the placement of the back foot, that is, the stance, of the golfer. If the examiner has evidence or a scientific explanation supporting the contrary allegation made in the answer (page 9), then the same should have been made of record.

Accordingly, on this record, we reverse all of the grounds of rejection.

The examiner's decision is reversed.

Reversed

CHARLES F. WARREN
Administrative Patent Judge

TERRY J. OWENS
Administrative Patent Judge

JEFFREY T. SMITH
Administrative Patent Judge

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